

APPLICATION NO. 09/894,448
EXAMINER: STEPHEN M. D AGOSTA

RESPONSE FILED: 7/12/05
ART UNIT: 2683

REMARKS

This response is provided in association with the RCE filed on February 3rd and to an Office Action mailed November 3rd, 2004. With this response Applicant has amended a number of the claims, as above. Accordingly, claims 1-38, as selectively amended remain pending.

§112, second paragraph Rejection of Claims 2 and 22

On page 3 of the Action, claims 2 and 22 were objected to as "using all of said RF bandwidth if channel quality meets desired channel quality" appears to be confusing to the Examiner.

Applicant maintains its position from previous responses, that is, that use of the term RF bandwidth is well defined and supported within the specification and, as such, its meaning within the scope of the claims is clear (*see*, e.g., page 5, line 30 through page 6, line 15; page 6, line 24 through page 7, line 5; page 11, line 8 through page 12, line 7; page 13, line 27 through page 14, line 16).

Applicant respectfully submits that reading the term RF bandwidth to include time slots, as the Action would suggest, is inconsistent with the usage of this term throughout the specification, and renders certain claims, essentially, nonsensical. In general, the Action has equated the number of timeslots used (Cudak) to the amount of RF bandwidth allocated. Thus, the Action contends, the selective reduction of RF bandwidth (as claimed) is anticipated by Cudak where the Action suggests the number of timeslots are selectively reduced to improve a channel quality parameter. However, in certain independent (e.g., 35 and 37, discussed more below) and dependent claims, the selective reduction of bandwidth is accompanied by *an increase* in the number of timeslots allocated to the channel in an attempt to maintain channel throughput. Thus, the Action would require a reading of such claims as "reducing the number of

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timeslots [reducing the RF bandwidth] only to then increase the number of timeslots in an attempt to maintain channel throughput" – a reading which is inconsistent with the plain meaning of the claim language, and the teachings of the specification.

Nonetheless, in an effort to conclude prosecution of this matter, Applicant has amended the claims, including 2 and 22, replacing use of the term bandwidth with spectrum. Support for the amendments can be found in the original specification, claims and/or figures and, as such, no new matter has been introduced.

In view of the amendments to, e.g., claims 2 and 22, Applicant respectfully submits that the §112, second paragraph, rejection has been overcome. Accordingly, Applicant respectfully requests that the rejection of claims 2 and 22 be withdrawn.

§102(e) Rejection of Claims 1, 8-11, 15, 17-21, 28-31 and 35-38

On pages 4-7 of the Action, claims 1, 8-11, 15, 17-21 and 28-31 were rejected as being anticipated by a patent issued to Cudak, et al. (USP 6,253,063) pursuant to 35 USC §102(e).

In response, without agreeing with or accepting the characterization of the claims or the cited reference as presented in the Action, in an effort to conclude prosecution of this matter, Applicant has amended the claims, as above, to specifically claim the selective reduction of RF spectrum as provided in, e.g., amended claims 1, 15, 21, 35 and 37.

It is well settled that in order to support a §102 rejection, the Office must establish that a single, prior art reference teaches each and every element of a claim, as such elements are presented within the rejected claim. In addition to the distinguishing features presented in previous responses, Applicant respectfully submits that the Cudak reference fails to teach or

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suggest the selective reduction in RF spectrum as presented in at least amended claims 1, 15, 21, 35 and 37.

Insofar as Cudak fails to teach each and every element of claims 1, 15, 21, 35 and 38 Applicant respectfully submits that the §102 rejection has been overcome, and respectfully requests that the §102(e) rejection of such claims be withdrawn.

Applicant notes that claims 8-11, 17-20, 28-31, 36 and 38 depend from patentable base claims 1, 15, 21, 35 or 37 respectively. Accordingly, in addition to any independent basis for patentability, Applicant respectfully submits that such claims are similarly patentable over the Cudak reference by virtue of at least such dependency. Thus, Applicant respectfully requests that the §102(e) rejection of claims 8-11, 17-20 and 28-31 be withdrawn.

§103(a) Rejection of Claims 2-4, 6, 7, 12, 13, 16, 22-24, 26, 27, 32 and 33

On pages 6-12, claims 2-4, 6, 7, 12, 13, 16, 22-24, 26, 27, 32 and 33 were rejected as being unpatentable over the Cudak reference in further view of a patent issued to Gilbert, et al. (USP 6,016,311) pursuant to 35 USC §103(a).

In response, Applicant maintains from previous response that the rejection of such claims have been traversed. Nonetheless, in an effort to conclude prosecution of this matter, Applicant has amended the independent claims, as above, to clarify that RF spectrum is selectively reduced to improve a channel quality parameter.

Applicant notes that the Gilbert reference is not cited as teaching, nor does it teach the deficient element of Cudak identified above, namely, selectively reducing RF spectrum allocated to a communication channel (or, element thereof, e.g., uplink or downlink element) to improve a quality parameter. Insofar as neither reference discusses reducing a channel's RF spectrum, they

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cannot reasonable be read as disclosing or suggesting such a feature. Thus, Applicant respectfully submits that claims 1, 15, 21, 35 and 37 remain patentable over the combination of Cudak and Gilbert.

Applicant notes that claims 2-4, 6, 7, 12, 13, 16, 22-24, 26, 27, 32 and 33 each depend from a patentable base claim 1, 15, 21, 35 or 37 respectively. Thus, in addition to any independent basis for patentability, Applicant respectfully submits that such claims remain patentable over the cited references by virtue of at least such dependency. Accordingly, Applicant respectfully requests that the §103(a) rejection of claims 2-4, 6, 7, 12, 13, 16, 22-24, 26, 27, 32 and 33 be withdrawn.

§103(a) Rejection of claims 5, 25 and 34

On pages 12-14 of the Action, claims 5, 25 and 34 are rejected as being unpatentable over the Cudak and Gilbert references in further view of a patent issued to Barlett, et al. (USP 5,557,603) pursuant to 35 USC §103(a). In response, Applicant traverses the rejection of such claims.

In particular, without accepting the appropriateness of the combination or the characterization of such references, Applicant notes that the Barlett reference is not cited as curing, nor does it cure, the limitation in the Cudak and Gilbert references of, e.g., reducing the RF spectrum allocated to a communication channel (or, subset thereof, e.g., an uplink or downlink element) to improve a quality metric. In this regard, Applicant respectfully submits that claims 1, 15, 21, 35 and 37, as amended, are patentable over the Cudak, Gilbert and Barlett references.

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Applicant notes that claims 5, 25 and 34 depend from patentable base claims 1 or 21 and, in addition to any other basis of patentability, are likewise patentable over the cited references by virtue of at least such dependency. Accordingly, Applicant respectfully requests that the §103(a) rejection of claims 5, 25 and 34 be withdrawn.

§103(a) Rejection of Claims 35-38

On pages 15-16 of the Action, claims 35-38 were rejected as being unpatentable over the Cudak patent in view of a patent issued to Naegeli (USP 6,574,797) pursuant to 35 USC §103(a). In response, Applicant respectfully traverses the rejection of such claims.

Applicant respectfully submits that in order to establish a prima facie basis of obviousness utilizing multiple references, the Office must present support for the proposed combination of the references. That is, the Office cannot simply rely on certain stated features from one source with other stated features of another source to obviate a claimed invention without pointing to some support for such combination *within the prior art, and not based on applicants disclosure (hindsight)* *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985); and *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). That is, a mere recitation of the desirability of the combination, made in hindsight is insufficient.

Insofar as the Office has failed to provide support for the proposed combination, Applicant respectfully submits that the Action has failed to establish a prima facie basis for the §103(a) rejection of claims 35-38 and respectfully requests that the rejection of such claims be withdrawn.

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Assuming, arguendo, that there is support for the proposed combination Applicant respectfully submits that the proposed combination nonetheless fails to disclose or suggest that which is claimed in, e.g., claims 35 and 37. More specifically, the proposed combination would fail to function in accordance with the claimed invention.

Recall from the §102 rejections above, the Action has essentially equated RF bandwidth to timeslots. Thus, in support of the §102 rejections above, the Action provides that to improve channel quality parameters, the number of timeslots of Cudak are reduced (thereby reading on Applicant's selective reduction of RF bandwidth). The Action acknowledges that Cudak fails to teach or suggest the selective reduction of RF spectrum to improve channel quality parameters, and thus introduces the Naegeli reference.

However, by the Action's own interpretation of these references, the combination of Cudak and Naegeli would, in essence, reduce not only the RF spectrum (Naegeli) allocated to a channel but also reduce the number of timeslots applied (Cudak) in an effort to improve the channel quality parameters.

In this regard, for at least the foregoing, Applicant respectfully submits that the proposed combination of the Cudak and Naegeli reference fail to disclose or suggest that which is claimed in rejected claims 35 and 37, which disclose the selective reduction in RF spectrum in combination with the selective increase in the number of timeslots allocated. Insofar as the proposed combination fails to disclose or suggest that which is claimed in rejected claims 35 and 37, Applicant respectfully requests that the §103(a) rejection of such claims be withdrawn.

Applicant notes that claims 36 and 38 depend from claims 35 and 37, respectively. Thus, in addition to any independent basis for patentability, Applicant respectfully submits that such claims are likewise patentable over the cited references by virtue of at least such dependency.

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Accordingly, Applicant respectfully requests that the §103(a) rejection of claims 36 and 38 be withdrawn.

CONCLUSION

Applicant respectfully submits that pending claims 1-38, as amended, are in condition for allowance, and earnestly awaits notice thereof. Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #50-0221. If the Examiner believes that there are any informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned is respectfully solicited.

Respectfully submitted,
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Dated: July 12, 2005

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